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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EX PARTE SHLOMO SHKOLNIK

Appeal 2009-005409
Application 09/914,487
Technology Center 2100

Oral Hearing Held: December 9, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and THU A. DANG, *Administrative Patent Judges*.

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ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for oral hearing on Wednesday,
2 December 9, 2009, at The U.S. Patent and Trademark Office, 600 Dulany
3 Street, Alexandria, Virginia, before Deborah Rinaldo, Notary Public.

4
5 MR. FENSTER: Since this is a very complex case, I would like to ask
6 for an extra ten minutes, if that's possible, depending on where we are at the
7 end.

8 JUDGE DIXON: Not possible. We have a scheduled 9:30 telephone.

9 MR. FENSTER: Okay. Fine. The prior art of database systems and
10 design systems has to solve two problems. The problems are related. One
11 of them is access and the other one is security.

12 And generally the access and security are solved by having a large
13 database to which access is limited to certain people and parts of the
14 database are even more limited, and that's exactly what Thackston has.

15 Thackston is a large system. It's shown in figure 2 of Thackston, and
16 it's a large system and all of the data -- all of the data that's needed as
17 indicated in the abstract, the invention relates to a comprehensive integrated
18 computer-based system.

19 All of the information that's necessary is in these databases 210, which
20 is a single database divided into separate parts because it's so big. And all
21 the rest of it is either users or ways for users to connect to the database.

22 Thackston recognizes that a user may have an intermediate design that
23 he will want to save until that design has been improved. And Thackston
24 suggests that the storage is in a scratch pad, 892, which you can see on
25 figure 8, and that's part of the database.

1 So basically while it does not say specifically that that scratch pad is
2 not available to the other users, as a matter of course, when you have an
3 unapproved part, it's not going to be available to others because if it is, then
4 the others will use it and mess up the entire system.

5 So what we have in Thackston is a big database and a portion of the
6 database which is used for, I call it, temporary storage.

7 Now, the present invention as described in the Application, let me talk
8 about that first, works on many different principles. The principle of the
9 present invention is to have individual databases which relate to individual
10 tools for design -- I'm sorry.

11 The present invention is based on a completely different idea. As
12 described in the disclosure, the idea is to have a separate database, only one
13 database which is available to everyone and that database, depending on
14 which claim you are looking at, does not allow for the design of anything.

15 Now, if you look at claim 32 in particular, and if you look at the
16 paragraph that starts, "gathering", Gathering by a computer, from the
17 plurality of computerized design tools, information on elements of different
18 systems of the vehicle, where the gathering includes retrieving from at least
19 one of the computerized tools information on fewer than all of the elements
20 of the vehicle required for the design of the system described by the tool,
21 storing it in an index and then opening the index for viewing by workers, at
22 least some of which are assigned to different systems of the vehicle from
23 each other.

1 Now we're talking here about the index being open. In other words,
2 viewable only by some of the users. And that's different between access
3 and -- access and -- by its very nature, the scratch pad.

4 Now, if I go back now to Thackston, Thackston has no database which
5 has all of those elements. Thackston has two databases. If you want to call
6 the portion of the database 892 a separate database, it has two databases.
7 And if we look at the three elements that I was just describing, one that it
8 contains information from a plurality of systems; two, that the information is
9 not enough to do any design; and third, that anyone can view it, if you look
10 at those three elements, if you start from the third element, which is that
11 everyone can view it, then that's only the main database of Thackston which
12 has all the information in it. So it doesn't meet requirement number two.

13 On the second possibility is to start from "contains information from a
14 plurality of systems." Well, Thackston has such a database, okay, but that
15 information in there, because of the comprehensive nature of the database, is
16 enough to do design.

17 So what we've done here is rather than have one big database with all
18 the information, something unportable and also hackable, what we've done is
19 to separate the information and have a separate database which does not
20 have enough information to do anything but which is accessible by everyone
21 because it doesn't include any specific design information for a particular
22 design tool.

23 Now, the advantages of doing this, aside from the security which I
24 just -- which I think is self-evident from the fact that you have blocked most
25 of the information for most users, the major advantage is that this database,

1 this new database that doesn't exist in Thackston is small enough so it's
2 portable.

3 And one of the big problems that you would find, just like we're
4 having trouble with communication, is if somebody has to keep going into a
5 large database and if he's at a remote location, he's going to find that he has
6 lots and lots of problems in designing in the normal way. And what this
7 system does is to allow somebody to have a database that's small enough so
8 that it can be used in many more situations. Now, that's the situation with
9 regard to claim 23.

10 With regard to claim 72, 72 actually is a derivative, if you will, of the
11 results of claim 23 but its element -- it has two elements in it which are not
12 in any of Thackston. The first is that it selects from a plurality of different
13 elements of each system and it has less than 10 percent of the elements.

14 Now, in addition to that, it has a second element that differentiates
15 from the prior art and that is that there's a reference to a worker in charge of
16 the element. Now, one of the problems when you have a large system is if
17 you come across an element that interferes with what you are trying to do,
18 you really don't know who to talk to.

19 Now, the Examiner points to Thackston where it says that access is
20 limited to certain people but access is not the same thing as a reference in the
21 element itself. So there's no indication in Thackston as to who is responsible
22 for the element.

23 There is an indication as to who can access the information. Now,
24 there might be a thousand people who can access the part but none of them,
25 except maybe one, would be the one that you would want to talk to if you

1 want to change the element. So claim 72 has those two features which are
2 not in Thackston at all.

3 And the Examiner has made a number of arguments, including an
4 argument that this is just a telephone book or it's like a telephone book and
5 anybody who sees a telephone book would know that you want to have a
6 smaller database.

7 But clearly he wouldn't get any hint -- even if he would think that
8 from a telephone book, he wouldn't get any hint that you have 10 percent of
9 the physical elements, less than 10 percent for each unit, and that there's a
10 reference to a worker in charge of the element. He wouldn't get that from a
11 telephone book.

12 Now, that's in addition to the arguments that we made earlier in that in
13 a telephone book, each element of information, each name and telephone
14 number is in and of itself useful. So it makes sense that if you want to have
15 only one neighborhood, for example, or only people in a certain profession,
16 that you have a listing which is limited to those, but every single piece of
17 data is a piece of data that can be used.

18 Whereas, if you have a database and you try to shrink it down to 10
19 percent or less of the number of elements in the database, you end up with
20 something that any person would say is not useful. And in fact, in the
21 absence of people having their own database which is specific to the tool
22 that they are working with, it wouldn't be useful.

23 The next claim that I want to talk about is claim 86. And here I want
24 to point to determining from the database by the worker which elements of
25 systems other than the system to which the worker is assigned are directly

1 affected by a possible change in an element of the vehicle in the system to
2 which the worker is assigned.

3 And Thackston just doesn't have that. There is no interaction at all in
4 Thackston. And here as well we have the limitations that we had in claim
5 23. That's the paragraph that starts "determining." Here we have the same
6 elements that we had in claim 23. For example, including information from
7 fewer than all the elements of the vehicle and we're choosing elements based
8 on fewer than all the elements of the system. Thackston does not have a --
9 any mechanism like those.

10 If we go to 86, 86 -- I'm doing the independent claims first. If we go
11 to claim 86, claim 86 also has selecting fewer than 10 percent of the physical
12 elements and also has the reference to the worker in charge but it also has an
13 -- an additional point, okay, is that this database is open to a plurality of
14 departments.

15 Now, in Thackston, the only reduced-size database that they have is
16 scratch pad 892 which is not open to people in a plurality of departments or
17 disciplines, but only those who are actually working on this device.

18 And last, we have claim 92 which the Examiner has characterized, if I
19 can recharacterize it, as being a for-use claim, that everything past the
20 preamble is only for use. And that's just not correct.

21 If you look in claim 92, claim 92 says -- because it's not very long -- a
22 computer system having stored therein a database for storing parts,
23 information in a working environment, including a plurality of different
24 departments -- that's a use, if you will -- assigned to perform different staff
25 tasks of respective different aircraft systems in which at least some of the

1 parts are assigned a worker code that indicates worker responsibility for the
2 design part and also having a database that associates each of the worker
3 codes with one or more workers responsible for the design.

4 Now, this describes the database that's in the computer system and that
5 database is different from ordinary databases. In ordinary databases where
6 you do have a database which might tell you who is assigned to a particular
7 part, what you would end up with is a long list of parts and each part has
8 associated with it a person in charge.

9 Now, the problem with that is that when people move from jobs to job
10 or there are multiple people who are involved, it becomes extremely difficult
11 to change the person who is involved.

12 Here you have only a listing of the number of people. When a person
13 moves from department A to department B, he automatically will be in
14 charge of certain parts and somebody else will become in charge of his parts.

15 Now, if we have a worker code with each part, we don't have to
16 reassign each of the parts. We only have to reassign the names that go with
17 each worker code. And that is a tremendous saving in time, energy and
18 simplicity.

19 I'm done. I don't want to talk about the dependent claims. There is a
20 dependent claim for one percent, a database with only one percent of the
21 parts, and that just goes further than the 10 percent one.

22 JUDGE DANG: Can I go to claim 23? I understand you are saying
23 the invention is different from Thackston. I guess I just want for you to
24 point out specifically the language where you are saying you have two -- I

1 mean, you only have one database -- I'm sorry. You have a database that
2 you cannot have design capability in it. Where is that in the claim?

3 MR. FENSTER: At the end of the paragraph that starts "gathering."
4 Fewer than all the elements of the vehicle required for design from the
5 systems required by the tools.

6 Thackston does not have a database which has fewer than all the
7 elements required for design. It has already data in the database, all the data
8 needed by everyone. So not only does it have enough to be designed by any
9 one design tool, it has enough to be designed by all the design tools.

10 JUDGE DANG: But doesn't "gathering all" include gathering fewer
11 than?

12 MR. FENSTER: No. If you make a specific statement on gathering
13 fewer than, then it says, "gathering fewer than all." If you look at the end of
14 that paragraph, it says -- at that point it's actually raised, I think, by the
15 Examiner, fewer than all the elements of the vehicle. And Thackston is a
16 standard system in which all the elements of the vehicle are gathered.

17 JUDGE DANG: That's all I have.

18 JUDGE DIXON: One question on that is, in the method, what if how
19 your method steps -- if you were in the middle of a design where you
20 distinguish where you haven't gotten all your data yet, wouldn't you have
21 fewer than all elements of a vehicle required for design of a system
22 described by the tool?

23 MR. FENSTER: Well, I would think that it's true that you might have
24 your standard parts in your system but when somebody designs an element

1 of the system, he does not put any -- for example, let's say someone designed
2 a wing.

3 Until he's finished with designing the entire wing, he's not going to
4 have parts that he's going to put in and have them approved because those
5 parts are so subject to change, and the idea of having approved parts, it's so
6 that other people can use them in what they are doing.

7 So then he might have what he has in a minor database of his own, a
8 kind of flat file where he would be doing his design in his design tool, but he
9 wouldn't have a database which has just random parts. I don't think that that
10 would be what you have.

11 JUDGE DIXON: So you would distinguish a working database in the
12 design phase versus a completed design which would be shared? Yours
13 would be a shared completed works as opposed to works in progress?

14 MR. FENSTER: Yes.

15 JUDGE DIXON: Is there any language in the claim that would flesh
16 that out?

17 MR. FENSTER: Just give me a second.

18 JUDGE DIXON: And then we're going to have to wrap up because in
19 a few minutes we're going to have a telephone call coming in.

20 MR. FENSTER: Well, the design tools are suggested for carrying out
21 a design task of a particular system and if they don't have all the parts, then
22 they can't do the design of the particular system.

23 So I think that that's one place. And I think that in the gathering, there
24 is implied that the computerized design tool has information that's sufficient

1 to do the design because otherwise the rest of it wouldn't make much sense.

2 You are only taking some of the parts out.

3 JUDGE DIXON: Okay. Is there anything else, anyone? No.

4 MR. FENSTER: Just one more point. If you had an index which had
5 parts that were not finished, okay, then you wouldn't open that index for use
6 by other people. It's not explicit. It's not explicit, you are correct.

7 JUDGE DIXON: Okay. Thank you very much.

8 (Whereupon, the proceedings were concluded on Wednesday,
9 December 9, 2009.)